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EXAMINER
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CHAPMAN, JEANETTE E

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/509,822  
Filing Date: September 30, 2004  
Appellant(s): ELMER, HUBERT

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Alfred W. Froebrich  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/21/08 appealing from the Office action mailed 4/18/08.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: the first rejection statement should include the Oscari reference (3685240) since the body of this rejection includes reference to this prior art. Therefore the new ground of rejection should read:

**GROUND OF REJECTION TO BE REVIEWED IN APPEAL**

1.

Whether claims 10-14 and 17-20 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 94/27019 (WO '019) in view of DE 3425765 (DE '765.), US Patent 3,685,240 (Oscari) and U.S. Patent 4,912,898 (Holmes).

Art Unit: 3633

2.

Whether claim 21 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '019 in view of DE '765, U.S. Patent 3,685,240 (Oscari) and Holmes and further in view of JP 2003268907A (JP '907).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,912,898	HOLMES	4-1990
3,685,240	OSCARI	8-1972

German Patent No.: DE 34 25 765  
Inventor: Marinoni et al  
Title: "Toughened Glass Double Action Door"  
International publication date: 11/24/1994.

International Publication Number: WO 94/27019  
Inventor: Peter Eutebach  
Title: Connector for Securing Plate Like Wall Components  
International Publication Date: 11/24/1994

Abstract Publication Number: JP 2003268907A  
Patent Assignee: NIPPON SHEET GLASS COMPANY LTD  
Title: Fire-proof glass panel assembly includes several fire-proof glass panels which are connected in lattice shpe through sealing joint having silicone rubber made hollow gasket filled with foam.  
Publication Date: 3/18/2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Art Unit: 3633

Claims 10-14, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT WO 94/27019 in view of DE 3425765 and Holmes (4912898)

PCT 27019 discloses a glass separating wall comprising :

- A pair of frameless side panels 3,5 mounted between a top structure and a base
- A frameless transom panel 8 between the side panels 2,5; the transom panel 8 being held by the side panels 3,5 and the top structure
- A rotatable door leaf 4 between the side panels and below the transom panel 8
- The door leaf 4 being rotatably supported exclusively by the transom panel, at the hinge 9, and at the base by the hinge 2
- The fittings inherently comprising complementary first and second fitting parts secured to the door leaf and then to the transom
- The first and second fittings 2,9 cooperating to permit rotation
- The side panels 3,5 and the transom panel 8 are fastened to one another by and to the top structure and the base without the fitting which support the door leaf
- The side panels, the transom and the door leaf have a uniform grid dimension and are arranged in a common plane as shown in figure 1
- The side panels and the transom panel each have longitudinal abutting edges; the abutting edges of the transom panels being connected to the abutting edges of the side panel; see figure 1

DE '765 discloses a glass separating wall with a side panel 28, a transom 26, and a door leaf. The wall further comprises:

- The door leaf 2 being rotatably supported exclusively by the transom panel, at

Art Unit: 3633

the hinge 22, and at the base by the hinge 6

- The fittings inherently comprising complementary first and second fitting parts secured to the door leaf and then to the transom
- The first and second fittings cooperating to permit rotation
- The side panels 28 and the transom panel 26 are fastened to one another by and to the top structure and the base without the fitting which support the door leaf
- The first and second fitting part comprises pins 14 and 22 and the other of the fitting comprise a bearing brush which receives the pin; see figure 1

In view of the above it would have been obvious to one of ordinary skill in the art to modify PCT '019 to include the pin and bearing fitting of DE -765 to keep with the minimalist structure of the wall as shown by DE.

PCT also lacks the permanently elastic mass between the transom panel and the side panels and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass. Holmes discloses glass panels with permanently elastic mass 53/59 between the transom panel 95/96 and the side panels 13/95 and the transom panel being connected in frictional engagement with the side panels by the permanently elastic mass 53/58. See figures 12 and 13. The elastic mass is made of silicon.

It would have been obvious to one of ordinary skill in the art to set the side panels and the transom using the silicone in order to provide a reflective glazing compound to produce a continuous, smooth, reflective surface with appropriate exterior glass sheets.

Art Unit: 3633

Oscari, figures 1 and 8, discloses the glass separating wall including frameless side panels, a transom panel and a door leaf. Oscari includes a top and bottom structure 11,12. Each of the top and bottom structure includes a channel and the side panels engaging the channels. The side panels being connected in frictional engagement with the top and the base by permanent elastic mass 17. See figures 18-19 and column 3, lines 40-42. If the elastic mass 17 engages the panels, then the elastic mass between the side panels and the transom, taught by Holmes, would also inherently be engaged by element 17 also to provide a flat surface across the glazing system. Oscari also discloses the side and transom panels fastened to one another and the base independently from fitting which support the rotatable door. See figures 1,8 and 9.

In view of the above, it would have been obvious to one of ordinary skill in the art to modify the base reference to include the top and base structure engaging channels and the separate engaging structures for the door leaf, side panels and transom panels in order to provide a unitary but strong structure.

PCT '019 lacks the vertically oriented stiffening elements supported on the base and arranged against the side parts perpendicular to the side parts. Oscari discloses a frameless glazing system with leaves and fixing. Oscari also discloses the vertically oriented stiffening elements 60 supported on the base and arranged against the side parts perpendicular to the side parts. It would have been obvious to one of ordinary skill in the art to include these stiffening elements to strengthen the structural integrity of the glazing elements as shown by Oscari.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT WO

Art Unit: 3633

94/27019 in view of DE 3425765, Oscari and Holmes (4912898) and further in view of JP 2003268907A. PCT '019 lacks the transom panel fastened to the side panels and top structure only by the elastic mass. JP 907 discloses glazing panels 10 secured to each other 100 and the other structure 12 only by elastic mass 30. It would have been obvious to one of ordinary skill in the art to modify PCT '019 to include the above recited method of securement in order to improve the fireproofing properties, to facilitate assembly and to improve the external appearance of the glass panels assembly.

#### **(10) Response to Argument**

Applicant states/ argues that Independent claim 10 recites, at least, "a permanently elastic mass arranged between the transom panel and the side panels and in the channels" and "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass.". Holmes discloses a permanently elastic mass 58 arranged between the transom panel 96 and the side panels 95 and Oscari discloses the elastic mass 17 in the channels 16" and the combination of references teach "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass.". The motivation for combining references provided above; additionally one of ordinary skill in the art would add the elastic mass to the structure of the base reference to keep moisture out.

Therefore regarding Independent claim 10 is obvious over the cited art for the following reasons:

(i) the combined art does disclose the above features recited in independent claim 10



Art Unit: 3633

because the glass panel assemblies in Holmes are connected by the exterior sealant 58, as is found in the Final Office Action, and also by an interior frame work member such as a mullion 45; and

(ii) there is motivation for one skilled in the art to modify the connectors of WO '019 with Holmes's teachings of butt joints, as is proposed in the Final Office Action, as such proposed modification of WO '019 would not change its principle of operation U.S. Patent 3,685,240 to Oscari is believed to have been relied on for this rejection.

(i)

Applicant further argues, "WO '019 concerns a connector for securing plate-like wall components. In WO '019, the connector is formed so that it requires only a centering and/or semicircular hole, instead of complex cutouts, in the glass plates. More specifically, the connectors of WO '019 are designed as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together, e.g., by means of a threaded fitting. See, page 3 of the English translation" The elastic mass is seen as a substitute/addition to the connector halves 10, 15, 22 to provide a water proofing treatment to the panels

Applicant further argues, "Holmes teaches forming glass panel assemblies 10a, 10b and securing the same to mullions 45, which is connected to a building's supporting structure. For example, Holmes teaches that the glass panel assembly 10a is positioned against the mullion 45, as is shown by phantom lines "C" and the repositioned as

Art Unit: 3633

indicated by solid lines "D" in Fig. 4. Once assembly 10a is properly positioned, it may be secured to mullion 45, as is shown in Fig. 5. For example, the glass panel assembly 10a can be glazed to the mullion 45 by glazing compounds or sealant 55 (see, col. 8, 11.24-27 of Holmes)." The examiner is not bodily incorporating Holmes into the base reference of WO '019. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981 ).

Hence, the rejection above does not use/incorporate the mullion 45 of Holmes into the design of WO '019. See motivation statement above. Holmes is cited to show the elastic mass between the glass panels to directly join the same to one another without the gaps between the panels. This elastic mass is obviously included for a reason. Holmes, column 9, lines 13-19 state, "Application of the exterior sealant 58 produces a glazed exterior butt joint of superior appearance and strength. Sealant 58 may beneficially comprise a silicone gun or rope caulking and may advantageously employ a reflective glazing compound to produce a continuous, smooth, reflective surface with appropriate exterior glass sheets.

Hence, the combination of WO '019 and Holmes and Oscari teaches or suggests "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass" as recited in independent claim

Art Unit: 3633

10.

Applicant also argues, "Moreover, appellants submit that one skilled in the art will not be motivated to substitute the alleged permanently elastic mass 53/58 in Holmes for the connectors in WO '019 as is suggested in the Final Office Action. As appellants submitted above, WO '019 is conceived to form its connectors as connector halves 10, 15, 22, which are adapted to be inserted into the hole in the glass plate from both sides and are then bolted together. If such connectors in WO '019 are replaced by the alleged permanently elastic mass 53/58 taught by Holmes, as is suggested in the Final Office Action, then not only the principle of operation of the connectors disclosed in WO '019 will be altered but the underlying invention disclosed in WO '019 will be null." This statement is applicant's interpretation of the references. Applicant has not proven and shown how that the combination of the base reference and the elastic mass renders the invention disclosed in the base reference null.

In view of all the above, the combined cited art does teach "a permanently elastic mass arranged between the transom panel and the side panels and in the channels" and "the transom panel being connected in frictional engagement with the side panels and with the top structure by the permanently elastic mass" as recited in independent claim 10. The Final Office Action thus has established a prima facie case of obviousness with respect to independent.

Applicant argues, "Claim 21 recites that "the transom panel is fastened to the side panels and the top structure solely by the permanently elastic mass.", The Final Office Action takes the position that "JP 907 discloses glazing panels 10 secured to each other

Art Unit: 3633

100 and the other structure 12 only by elastic mass 30." Appellants respectfully disagree. In the English abstract, JP '907 teaches that the "panels are supported by the metal support (12) arranged at four sides of the panel, at preset interval." Accordingly, the glass panels 10 in JP '907 are not only connected by the sealing joint 30 but also supported by the metal support 12. Therefore, JP '907 does not teach that "the transom panel is fastened to the side panels and the top structure solely by the permanently elastic mass," as is recited in claim 21." To clarify, "the glass panels are **connected** in lattice shape solely through sealing joint 30 and the panels are **supported (not connected)** by the metal support 12.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeanette E Chapman/  
Primary Examiner, Art Unit 3633

Conferees:

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Supervisory Primary Examiner  
Art Unit 3633

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